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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/613,361

07/10/2000

Jay S. Walker

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9450

22927

7590

02/23/2007

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/613,361	<b>Applicant(s)</b> WALKER ET AL	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 70-79 and 81-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70-79 and 81-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 70-79 and 81-91 are pending in this communication filed 11/28/06 entered as Response After Non-Final Action.

#### ***Oath/Declaration***

2. The Declaration is objected to for the following: "Prior U. S. Provisional Application(s)" section has 08/762,128 listed as pending and application 08/858,738 as pending. Application 08/762,128 should be listed as issued – patent no. 5,798,508 and application number 08/858,738 should be listed as abandoned.

#### ***Claim Objections***

3. Claim 80 is objected to because of the following informalities: Claim 80 recites "... account, and in which the account ...; and distributing .... ". These claim limitations to be in proper method step claim format should recite "... account, in which the account ...; and distributing ...". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 70-79 and 81-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,684,291) Taskett.

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With respect to claims 70, 73, 76, 77, 78, 79, and 85, Taskett discloses, A method, a system, a computer-readable storage medium encoded with processing instructions for implementing a method for issuing a gift certificate corresponding to a financial account, comprising the steps of: generating, by a computer, a certificate identifier corresponding to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier (col. 3, lines 1-21, col. 5, lines 36-49, and Fig. 2); producing a gift certificate including thereon said certificate identifier (col. 3, lines 21-26 and col. 4, lines 21-26); and distributing said gift certificate to an owner of said financial account (col. 3, lines 38-35, col. 4, lines 35-48, Fig. 1A and Fig. 1B). Taskett discloses a pre-paid telephone card which is analogous to a gift certificate since the pre-paid phone card has a telephone account associated with an identification code and a replacement code associated with an identifier code with the account identifier not on the phone card and distributing the phone card to the owner of an account. The phone card identifier in one instance corresponds to the account identifier and the phone card has an alias identifier (the code that has to be scratched off the card prior to use).

With respect to claims 73, 77, and 79 Taskett further discloses, a computer means and distributing said gift certificate to a recipient (col. 2, lines 10-12 (computer system) and col. 4, lines 57-67).

With respect to claims 71 and 74, Taskett discloses, wherein the financial account identifier cannot be discerned from the gift certificate identifier by a third party (col. 3, lines 33-27).

With respect to claims 72 and 75, Taskett discloses, further including the steps of: receiving an indication of a gift certificate redemption (col. 4, lines 49-63); and updating stored account data to reflect the redemption (col. 2, lines 10-12, col. 4, lines 33-38, and col. 6, line 61-col. 7, line 17).

With respect to claim 81, A method comprising: Taskett discloses, producing a gift certificate (col. 3, lines 1-21, col. 5, lines 36-49, and Fig. 2); and in which the account identifier identifies a credit card account; and distributing the gift certificate to an owner of the credit card account (col. 5, line 62-col. 6, line 12).

Taskett does not expressly disclose, the gift certificate including a sixteen-digit identifier, in which the sixteen-digit certificate is an alias of an account identifier that identifies a financial account. The fact that a gift certificate has a sixteen-digit identifier is considered a design choice. However in Figure 2, Taskett shows a sixteen-digit certificate number that can be used as an alias account identifier to identify a financial account.

With respect to claims 82 and 84, Taskett discloses, in which the gift certificate is for a single use (col. 6, line 61-col. 7, line 10).

With respect to claims 83 and 91, Taskett discloses A method comprising: determining stored account data associated with a financial account (col. 7, line 46-67), in which the account data includes an account identifier that identifies the financial account (col. 8, lines 1-11); generating an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier (col. 2, lines 3-13; producing a gift certificate, the gift certificate including the alias

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identifier (col. 3, lines 27-37); and providing the gift certificate to a recipient (Col. 4, lines 13-34). Taskett does not expressly disclose an indirect link to the financial account. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate an alias identifier that provides an indirect link to the financial account, in which the alias identifier is different from the account identifier; and to modify in Taskett because such a modification would allow Taskett to have a predetermined number sequence corresponding to the serial number of a particular money order form (gift certificate) which is considered an alias identifier.

Claim 91, Taskett fail to disclose the alias account number comprises at least fifteen numeric digits (Col. 6, line 53-col. 7, line 25 and Fig. 2 -shows an account number with at least fifteen numeric digits); a magnetic stripe card, the magnetic stripe card including the alias account number (col. 3, lines 46-56); and providing the magnetic strip card to a recipient (col. 3, lines 46-56, col. 4, lines 21-26, and col. 6, line 61-col. 7, line 25).

With respect to claim 85, this dependent claim is rejected for the similar rationale as given above for claims 70, 73, and 76-79.

With respect to claim 86, this dependent claim is rejected for the similar rationale as given above for claim 81.

With respect to claim 87, Taskett discloses, The method of claim 83, in which the recipient is an owner of the financial account (col. 5, lines 62-66).

With respect to claim 88, Taskett discloses, The method of claim 83, in which the financial account is a credit card account (col. 6, lines 45-52).

With respect to claim 89, Taskett discloses, The method of claim 83, in which the financial account is a checking account (col. 6, lines 45-52).

With respect to claim 90, Taskett discloses, The method of claim 83, in which the gift certificate comprises at least one of: a paper certificate (printed receipt)-col. 3, lines 8-26)); a stored value card (col. 4, lines 49-67); and a magnetic stripe card (col 3, lines 46-56). A pre-paid card always has a stored value. The value being whatever amount of the card that you purchase.

### ***Response to Arguments***

6. Applicants' arguments filed 11/28/06 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: We assert that Taskett fails to teach or suggest issuing a gift certificate identifier that corresponds to a financial account, wherein the gift certificate includes a certificate identifier that corresponds to an account identifier associated with the financial account, neither of the authorization code or the replacement code corresponds to an account identifier associated with a financial account and we therefore submit that Taskett does not teach or suggest a gift certificate that includes a certificate identifier that corresponds to an account identifier associated with a financial account has been considered but are not persuasive. Response: The Examiner respectfully submits, that Taskett is analogous art applied to the claim limitations. As discussed above in the rejection of claims 70-79 and 81-91. The distribution of a phone card is analogous to Applicants' gift certificate because as shown

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in Fig. 2 the phone card has an account number and there is an owner of the financial account which the phone card is distributed to.

Applicants' fail to appreciate the breadth of the claims. In particular the Tasked reference discloses what is considered analogous to a gift certificate by using a phone card.

Further Applicants' are applying a more stringent standard to the reference than to the limitations of the claims. This is a reversal of their appropriate roles, as the reference is used as a whole as a teaching in light of the level of skill in the art. In particular it is well known that when someone purchases a gift certificate that the certificate number that is on the certificate is different from the account number used to purchase the gift certificate and the gift certificate doesn't include an account number and the certificate is given to the owner of the credit card account.

These are all steps performed when a gift certificate is purchased for example at Macy's Department Store or some other store. The Examiner has prior knowledge from having issued many gift certificates during being employed by Macy's for the holidays over twelve years ago.

Issue no. 2: Applicants' argue: We additionally submit that Taskett fails to suggest or teach to produce a gift certificate with a certificate identifier that is an alias of an account identifier or financial account or credit card account as recited by independent claims 81, 83, and 91 and in particular, Taskett does not teach or suggest providing an alias for any identification number, and Taskett does not mention any such "special program generated security numerical indicia", whatever that may mean has



been considered but is not persuasive. Response: The Examiner has attempted to clarify the rejection of claim 81 above. It is noted that claim 81 should have technically been restricted because the other independent claims do not contain the claim limitations of a gift certificate including a sixteen digit identifier, the sixteen digit certificate being determined by a computer, an alias of an account identifier, and a credit card account and the claim limitations of claims 83 and 91 also differ from the other claim limitations of the independent claims.

Furthermore, Applicants' claim 70 is a broader version of claim 1 of the 11/423,161 co-pending application.

Conclusion: The court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during examination of a patent application since the applicants' may then amend the claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified by the Patent and Trademark Office is not required, in the course of prosecution, to interpret claims in patent applications in the same manner as courts interpret claims during infringement suits; instead, PTO applies to language of the proposed claims the broadest reasonable meaning of words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description in Applicants' specification. *In re Prater*, 162 USPQ 541 (CCPA 1969) and *In re Morris*, 44 USPQ2d 1023 (Fed. Cir. 1997).

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Claims in a pending application should be given their broadest possible interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974)

### **Inquiries**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 19, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER